

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/063,181 05/14/93 PAULSON

J 1413755

EXAMINER

FONDA, K

ART UNIT

PAPER NUMBER

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1803

DATE MAILED:

10/19/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8-17-95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), — days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

TIME LIMIT OF ONE MONTH ALSO RUNS FROM THE DATE OF THIS LETTER

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449. 4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.. 6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-66, 81-94, 99-103, and 107-128 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 67-80 and 95-98 and 104-106 have been cancelled.
3. ☒ Claims 99-103 and 107-127 are allowed.
4. ☒ Claims 128 is are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

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Applicant's election of Group IV in Paper No. 7 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).

The drawings are again objected to by the Examiner as set forth in the previous Office action because in Figure 12B, a hydroxyl group appears to be missing from C-2 of the galactose moiety which is bound to neuraminic acid. The drawings are also objected to by the Official draftsman as set forth on Form 948 enclosed with the previous Office action. Correction is required. The Examiner notes that Applicant's response to the Office action of 03-13-93 did not acknowledge these objections.

Claim 128 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 128 is of indeterminate scope in that the compounds have a "dangling valency" (see *Ex parte Diamond* (POBA 1959) 123 USPQ 167) at C1 of the glucose moiety.

Claims 99-103 and 107-127 are allowable over the prior art of record. Claim 128 is rejected. Claims 1-66 and 81-94 are withdrawn as being directed to non-elected inventions.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P.

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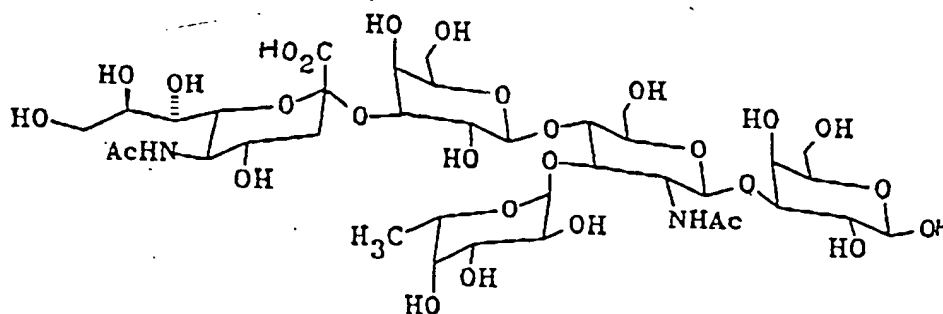
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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

The following claim corresponding to claim 6 of U.S. Patent No. 5,428,025 is suggested to Applicant under 35 U.S.C. § 135(a) for the purposes of an interference:

A method of treating inflammation, comprising administering to a patient a therapeutically effective amount of a compound having the structural formula



The suggested claim must be copied exactly, although other claims may be proposed under 37 C.F.R. § 1.605(a).

APPLICANT MUST COPY THE PATENT CLAIM WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. THE EXTENSION OF TIME PROVISIONS OF 37 C.F.R. § 1.136(a) DO NOT APPLY TO THIS TIME PERIOD. FAILURE TO COPY THE CLAIM WILL BE TAKEN AS A CONCESSION THAT THE SUBJECT MATTER OF THIS

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CLAIM IS THE PRIOR INVENTION OF ANOTHER UNDER 35 U.S.C. § 102(g) AND THUS ALSO PRIOR ART UNDER 35 U.S.C. § 103. *In re Oguie*, 186 USPQ 227 (CCPA 1975).

Applicant need not respond to the remaining issues in this action if a suggested claim is copied for the purpose of an interference within the time limit specified above. See 37 C.F.R. § 1.605(b).

Papers relating to this application may be submitted to Group 1800 by facsimile transmission. The number of the fax machine located in the Examiner's art unit is (703) 308-4227. The cover sheet of any document submitted by facsimile transmission should be clearly marked as either an official or an informal communication.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached from Monday through Thursday, as well as on alternate Fridays, between 7:30 a.m. and 5:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner Douglas W. Robinson, at (703) 308-2897. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

KUF
Kathleen Kahler Fonda, Ph.D.


DOUGLAS W. ROBINSON
SUPERVISORY PATENT EXAMINER
GROUP 1800